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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/845,643	04/30/2001	Srikar Rao		3965

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EXAMINER

WONG, STEVEN B

ART UNIT PAPER NUMBER

3711

DATE MAILED: 10/28/2003

18

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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Paper No. 18

Application Number: 09/845,643  
Filing Date: April 30, 2001  
Appellant(s): RAO, SRIKAR

**MAILED**  
**OCT 28 2003**  
**GROUP 3700**

\_\_\_\_\_  
Richard Lazarus  
For Appellant

**EXAMINER'S ANSWER**

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This is in response to the appeal brief filed August 27, 2003.

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**(1) *Real Party in Interest***

A statement identifying the real party in interest is contained in the brief.

**(2) *Related Appeals and Interferences***

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

**(3) *Status of Claims***

The statement of the status of the claims contained in the brief is correct.

**(4) *Status of Amendments After Final***

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) *Summary of Invention***

The summary of invention contained in the brief is correct.

**(6) *Issues***

The appellant's statement of the issues in the brief is correct.

**(7) *Grouping of Claims***

Appellant's brief includes a statement that claims 1, 4, 6, 9 and 13-18 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

**(8) *Claims Appealed***

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(9) *Prior Art of Record***

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4,386,774                      Buckman                      06-1983

5,393,052                      Kennedy                      02-1995

**(10)    *Grounds of Rejection***

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1, 3, 6, 7, 13 and 16-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Giglio. This rejection is set forth in prior Office Action, Paper No. 15.

Claims 4, 5, 9, 10 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Giglio in view of Kennedy. This rejection is set forth in prior Office Action, Paper No. 15.

Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Giglio in view of Buckman. This rejection is set forth in prior Office Action, Paper No. 15.

**(11)    *Response to Argument***

Regarding the rejection of claims 1, 3, 6, 7, 13 and 16-18, the appellant contends that it would not have been obvious to remove the golf tee attachment surfaces taught by Giglio.

However, the removal of the tee attachment surface amounts to nothing more than the removal of parts and their associated functions. See *In re Karlson*, 136 USPQ 184 and *In re Wilson et al.*, 153 USPQ 740.

Appellant's statement that the device of Giglio is nothing like that of the instant invention is without merit as the features upon which applicant relies are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

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In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Regarding the limitation for the clip to be sized for attachment to a shoe, the golf tool of Giglio is obviously capable of being attached to a shoe and thus, is obviously sized for attachment to a shoe. The pile section (40) of the glove, the ball marker (24) and the golf tee (26) all give a frame of reference for the size of the clip of the golf tool and none of these would lead one of ordinary skill in the art from believing that the clip is sized so that it is capable of being attached to a golf shoe. The appellant, argues that the accessory is too big and bulky to attach to a shoe, however, he appears to be relying on his own personal knowledge as to a preferred size for a golf accessory that is attached to a shoe. The instant claims fail to define this preferred size and merely require that the golf tool be of a size for attachment to a shoe. No mention is provided in the claim about comfort or injury as the appellant seems to believe and reads into the claim.

Regarding the limitation of claim 18 for the golf tool to be sized for attachment to a shoe, as stated above because the tool is capable of being attached to a shoe it is obviously shaped for attachment to a shoe. The appellant argues that the shape of Giglio would snap plants, golf carts or otherwise be an obstruction. However, the instant claims fail to define any particular

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characteristics for the shape other than that it be capable of being attached to a shoe. The arguments that the tool of Giglio would be an obstruction relates to appellant's subjective opinion on the tool of Giglio and is not based in fact.

The claims even when read in light of the specification fail to define a particular shape that is critical for achieving attachment to the golf shoe. The specification may note rounding of corners and such for the tool, however, these brief statements fall far short of defining a criticality for any claimed shape for the tool.

The argument that the Empire State Building is capable of being attached to a shoe is without merit here as the examiner is not applying something so disparate in scope as this example. The tool of Giglio is not only in a size that allows it to be attached to a shoe (as evidenced by the frame of reference of the tee and golf glove) but also it includes a clip similar to the clip of the instant invention that would allow it to attached to a shoe. Further, both devices are directed to portable golf tools that include a ball marker magnetically held thereon. Thus, it is clear that the tool of Giglio includes a number of similarities to the instant invention and is not as different as appellant seems to indicate by his Empire State Building example.

Regarding claim 6, attention is directed to column 3, lines 42-45 of Giglio stating that the tool is to be attached to an article of the golfer's clothing. A shoe would be obviously included in this teaching. In the alternative, it would have been obvious to one of ordinary skill in the art to attach the tool to a shoe in order to provide a convenient place for storing the ball marker and golf tool that would not hinder the golfer's swing.

Regarding claim 13, it would have been obvious to one of ordinary skill in the art to form the clip of Giglio from a monolithic piece in order to simplify construction of the clip by

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permitting processes such as molding. The formation of the golf tee holder of Giglio as a single integral piece instead of the referenced structures is a matter of obvious engineering choice. See *In re Larson, Russler and Meldahl* 144 USPQ 347. The appellant argues that it would not have been possible to manufacture the tool of Giglio from a monolithic piece as Giglio includes different material (magnet and non-magnetic parts). However, claim 13 does not state that the ball marker and means for retaining the ball marker are formed with the clip to comprise the monolithic structure. Claim 13 merely sets forth that the monolithic structure includes the legs of a generally U-shaped member which define the clip wherein the outer portion has a recess sized for receiving a ball marker. The claim uses the open language “comprising” and clearly leaves the possibility for additional structures to be added to the monolithic structure such as the magnet and non-magnetic structures of Giglio.

Regarding claim 16, the appellant appears to be relying on a particular definition that is not supported by the claims. Claim 16 merely defines a rim on the ball marker for facilitating removal of the ball marker from the recess. Evidently appellant interprets this rim to be specifically directed to a portion of the ball marker that extends beyond the recess in the body of the golf tool. However, this language is not presented in the claims. The ball marker of Giglio obviously includes a rim about its outer periphery. As taught by Giglio and reiterated by appellant, the user presses on the ball marker to pivot it out of the cavity 14 where it can be easily grasped. Thus, the rim of the ball marker is pressed by the user to pivot the marker and the rim is also grasped by the user to complete its removal from the cavity.

Regarding claim 17, the monolithic limitation has been already addressed in the remarks devoted to claim 13. Claim 17 also recites “means for releasably fixing a ball marker to the

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outer portion". The appellant argues that Giglio lacks this teaching as the means plus function necessarily entails the disclosed indentations (16) and recessed cavity (17) with a depth less than the thickness of the marker so that a portion of the marker extends from the recess and facilitates, with indentation 16 removal of the marker from the recess. However, it should be noted that the means plus function language of claim 17 relates to the means for fixing a ball marker to the outer portion and nothing else. The indentations and depth of the cavity would relate to a means for removal of the ball marker from the cavity and not the means for fixing the ball marker to the outer portion as recited. Here, the specification only defines a magnetic attachment between the ball marker and the outer portion as being the means for fixing the ball marker to the outer portion. Giglio clearly provides this same means by providing a ball marker (24) that is attached to the outer portion by a magnet (16).

Regarding the rejection of claim 4, the appellant argues that the examiner does not explain how one of ordinary skill in the art would replace the bottom surface of Giglio with the ball mark holding recess and indentation of Kennedy to arrive at the subject matter of claim 4. The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching,



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suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, both references are directed to golf tools and particular teach means for retaining and removing the ball marker from the tool body. Kennedy teaches facilitating removal of the ball marker from the recess by providing an indentation. This teaching by Kennedy suggests to one of ordinary skill in the art to include such an indentation in the construction of Giglio.

Regarding the rejection of claim 14, the appellant contends that the combination of Giglio in view of Buckman as proposed by the examiner would require substantial changes to the structure of Giglio and is also not suggested by the prior art. However, the rejection of claim 14 states that it would have been obvious to one of ordinary skill in the art to have the ball marker of Giglio extend slightly past the recess in order to facilitate removal of the ball marker. It appears that the appellant is in error in stating that the combination would require substantial changes to the structure of the Giglio as the proposed modification would merely require an increase in thickness of the ball marker. Nowhere in the rejection is there any statement that the pivoting removal method taught by Giglio is to be replaced with the sliding method of Buckman. The rejection merely argues that it is well known in the art of golf tools and more specifically golf ball markers to have the marker extend beyond the recess in order to facilitate its removal. Clearly, in both references by having the ball marker extend beyond the recess one of ordinary skill in the art would find the edge of the marker more readily to effect its removal from the tool. Extending the rim of the ball marker in the tool of Giglio would permit one of ordinary skill in

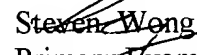
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the art to find the rim faster to facilitate its pivoting and subsequent removal from the ball marker.

In conclusion, it should be clear that appellant misconstrues the facts of the application and relies upon his own definitions that are neither present in the claims nor supported by the specification. Exception is taken to appellant's statement that the claims are summarily rejected without adequate explanation. Attention is directed to the rejections of the claims and the response to arguments where all of appellant's arguments have been properly addressed by the examiner.

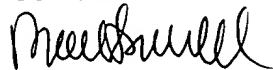
For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

  
Steven Wong  
Primary Examiner  
Art Unit 3711

SBW  
October 24, 2003

Conferees



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